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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,601	04/04/2006	Roman Arnet	UF-P276USw (432633-050)	4190
46188	7590	09/14/2009	EXAMINER	
SANDERS, JAMES M				
Nixon Peabody LLP 200 Page Mill Road Palo Alto, CA 94306			ART UNIT	PAPER NUMBER
			1791	
			MAIL DATE	DELIVERY MODE
			09/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,601

Applicant(s)

ARNET ET AL.

Examiner

JAMES SANDERS

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 6-13 is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a final Office action in response to a non-final Office action reply filed 6/11/09, in which claim 11 was amended.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blandin (US 4251474, already of record), and further in view of Martin et al (US 6039899).

For claim 1, Blandin teaches a method for separating a cast lens from a shell mold, the shell mold and the lens forming a composite, the method comprising: pressing a separating tool with a force on the lens (Fig. 3, cl 5 lns 51-55).

Blandin does not teach rotating either the composite so that the separating tool rolls passively on the lens or rotating the separating tool so that the lens rolls passively on the separating tool, and guiding the separating tool along an interface between the lens and the shell mold.

However, in the same field of endeavor pertaining to lens molding, Martin et al teach rotating the separating tool so that the lens rolls passively on the separating tool, and guiding the separating tool along an interface between the lens and the shell mold (Fig. 24, cl 42 ln 58 to cl 43 ln 12). Examiner notes that under a broad interpretation, when the separating tool (pry fixture 448) is rotated upward, the composite, which includes the lens, is free to roll some on the separating tool since it is not fixed therein.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Martin et al with those of Blandin for the benefit of increased reproducibility and convenience in performing the de-molding operation.

3. For claim 2, Blandin does not explicitly teach controlling the force according to a profile dependent on an angle of rotation of the shell mold. However, Blandin does teach careful removal to avoid damage to the shell mold (cl 5 lns 43-50) and therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the force applied depending upon the angular orientation of the shell mold so as not to cause any damage.

4. For claims 4-5, further regarding the motion of the separating tool taught as obvious by Martin et al above, Martin et al also teach applying a further force to either

the shell mold or the lens, wherein the further force is a tensile force that is already built up at the start of the separation process or is built up at least before the lens and the shell mold are completely separated from each other (cl 42 lns 65-68).

Allowable Subject Matter

Claims 3 and 6-13 are allowed.

The following is a statement of reasons for the indication of allowable subject matter. Blandin and Martin et al teach a few very broad elements claimed by applicant in the separation of a cast lens from a shell mold. However, these prior art references do not teach the many other specific elements further claimed by applicant including fixing the composite onto a holding device rotatable on an axis of rotation, adjusting a height of a separating tool and applying a force to the separating tool so that the separating tool presses against the lens adjacent to an interface between the shell mold and the lens, and rotating the holding device and continuously adjusting the height of the separating tool so that the separating tool follows a height of the interface according to the actual angle of rotation, etc. Further, Blandin and Martin et al do not teach the specific elements of the apparatus claimed for carrying out such a detailed method. Finally, no other prior art was found to show the more specific elements of the claimed methods or apparatus.

Response to Arguments

Applicant's arguments filed 6/11/09 were fully considered and are not persuasive.

First, applicant asserts that with Blandin the separating tool is not pressed on the lens, it is pressed in a gap between the lens and the shell mold and therefore the

limitation "pressing a separating tool with a force on the lens" is not disclosed by Blandin. Examiner, however, points out that when the tool is inserted between the lens and the shell to facilitate separation between the two, it is inherent that it is pressed on the lens.

Second, applicant submits that the metal fingers 452, 453 hold the front curve mold half, and therefore the front curve mold half and the lens which adheres to the front curve mold cannot rotate, so when the back curve mold half is removed from the composite of lens and front curve mold half, the lens remains fixed to the front curve mold half, and therefore the assertion in the Office Action that the lens is free to roll on the separating tool cannot be maintained. Examiner, however, articulates that the metal fingers 452, 453 keep the composite of lens and front curve mold half from moving upward, they do not restrain it from rotating. Therefore, it is inherent that when the separating tool (pry fixture 448) engages the composite and is rotated upward before complete removal of the back curve mold half, the composite, which includes the lens, is free to roll some on the separating tool since it is not rotationally fixed therein.

Third, applicant asserts that the person skilled in the art has no grounds to modify an efficient and well established process as disclosed by Martin by elements of a manual process as disclosed by Blandin. Examiner, however, points out that the person skilled in the art would modify a manual process as disclosed by Blandin for the reasons provided in the rejection of claim 1 above, that is, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the

teachings of Martin et al with those of Blandin for the benefit of increased reproducibility and convenience in performing the de-molding operation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JAMES SANDERS** whose telephone number is 571-270-7007. The examiner can normally be reached on Monday through Friday, 8 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMS

/Joseph S. Del Sole/
Supervisory Patent Examiner, Art Unit 1791